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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,492	03/09/2001	Kenneth Ronald Gersing	5405-254	7275
20792	7590	04/06/2006	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC PO BOX 37428 RALEIGH, NC 27627			NAJARIAN, LENA	
			ART UNIT	PAPER NUMBER
			3626	
DATE MAILED: 04/06/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/803,492	GERSING, KENNETH RONALD	
	<b>Examiner</b>	<b>Art Unit</b>	
	Lena Najarian	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 9-23,31 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-23,31 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 2/2/06. Claims 9-23, 31, and 35 remain pending. Claim 39 is canceled. Claim 23 has been amended.

### ***Drawings***

2. The objection to the drawings is hereby withdrawn due to the amendment filed 2/2/06.

### ***Specification***

3. The objection to the abstract is hereby withdrawn due to the amendment filed 2/2/06.

### ***Claim Objections***

4. The objection to claim 23 is hereby withdrawn due to the amendment filed 2/2/06.

### ***Claim Rejections - 35 USC § 101***

5. The rejection of claim 39 under 35 U.S.C. 101 is hereby withdrawn due to the amendment filed 2/2/06. However, the following rejections set forth in the prior Office Action remain:

Claims 9-23, 31, and 35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

(A) Claim 9 recites “a psychiatric information system comprising: a psychiatric dialogue box...” The current claim language does not clarify that a computer processor or structure is part of the recited system or that the recited elements (i.e. the database repository) are embodied and executable on a computer readable medium.

Data structures not embodied on a computer readable media are considered descriptive material. They are therefore considered non-statutory because they are not capable of causing a functional change in a computer. As drafted, the claim fails to define any structural and functional interrelationships between the dialogue boxes and other elements of a computer that permit the computer program's function to be realized. (See MPEP § 2106)

For a claimed invention to be statutory, the claimed invention must also produce a useful, concrete, and tangible result. Under this analysis, the present language of claims 9-23 merely recites non-functional descriptive material, as no recitation of executable code being embodied on any medium or data structure is provided. Simply stated, the “dialogue box” as recited in claim 9 fails to have a tangible result.

Similarly the database repository of claim 9, per se, is not statutory and is deemed to be a collection of non-functional descriptive material. While a database by itself may broadly be considered a means for storing data, it does not produce a useful, tangible and concrete result. The database is merely to be stored, to be read, or to be outputted (e.g. by a computer) without establishing any functional interrelationship, and thus does not impart any functionality to the computer (i.e. it is not a computer component).

In light of the above, it is respectfully submitted that the invention of claims 9-23, does not have a tangible result, and thus fails to recite the practical application of an abstract idea to satisfy the requirements of 35 U.S.C. 101.

As per claim 31, a similar 101 analysis may be applied to the language of claim 31, which recites similar language to that found in claims 9-23. Therefore, it is respectfully submitted that the invention of claim 31, also does not have a tangible result, and thus also fails to recite the practical application of an abstract idea to satisfy the requirements of 35 U.S.C. 101.

(B) Claim 35 recites " a computer program product for. . ." in the preamble. As drafted, the claim fails to define any structural and functional interrelationships between the code and other elements of a computer that permit the computer program's function to be realized (See MPEP § 2106). Therefore, it is respectfully submitted that the invention of claim 35 does not have a useful result and thus fails to satisfy the requirements of 35 U.S.C. 101.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9, 12, 14, 18-20, 31, and 35 are rejected under 35 U.S.C. 103(a) as being  
Y unpatentable over Bair et al. (6,067,523) in view of Ilse et al. (US 6,757,898 B1).

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(A) Claims 9, 12, 14, 18-20, 31, and 35 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

8. Claims 10, 11, 13, 15, 16, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bair et al. (6,067,523) in view of Ilсен et al. (US 6,757,898 B1), as applied to claim 1 above, and further in view of Lavin et al. (5,772,585).

(A) Claims 10, 11, 13, 15, 16, and 22 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bair et al. (6,067,523) in view of Ilсен et al. (US 6,757,898 B1) as applied to claim 1 above, and further in view of Lavin et al. (5,772,585) and Soll et al. (US 2003/0055679 A1).

(A) Claim 17 has not been amended and is rejected for the same reasons given in the previous Office Action, and incorporated herein.

10. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bair et al. (6,067,523) in view of Ilсен et al. (US 6,757,898 B1) as applied to claims 9 and 20 above, and further in view of Miller (5,235,702).

(A) Claim 21 has not been amended and is rejected for the same reasons given in the previous Office Action, and incorporated herein.

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11. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bair et al. (6,067,523) in view of Ilse et al. (US 6,757,898 B1) in view of Lavin et al. (5,772,585) as applied to claims 9 and 22 above, and further in view of Miller (5,235,702).

(A) The amendment to claim 23 was apparently made to overcome the claim objection set forth in the prior Office Action. However, this change does not affect the scope and breadth of the claim as originally presented and/or in the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same rationale given in the prior Office Action, and incorporated herein.

### ***Response to Arguments***

12. Applicant's arguments filed 2/2/06 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 2/2/06.

(1) Applicant argues that neither of the references, nor their combination, describes or suggests the use of discrete data elements in psychiatric treatment.

(2) Applicant argues that the motivation provided at Page 9 of the Official Action "to discover relationships among the data" is not the type of clear and particular motivation that is required by the MPEP and the case law. Finally, even if the references were somehow combined, they would merely provide "thousands of possible relationships that could possibly occur among patients, providers, staff, conditions, data elements

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and the like, to produce a proprietary architecture" as noted in the cited passage of Ilsen et al. The recitations of Claim 9 simply would not be described or suggested.

(A) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner respectfully submits that the Ilsen reference is directed to communications between a health-care or medical service provider and his/her patient. A psychiatrist would fall under the category of "health-care or medical service provider" (note col. 15, lines 13-21 of Ilsen). As such, Bair combined with Ilsen would suggest the use of discrete data elements in psychiatric treatment (note page 9 of the Office Action mailed 8/11/05).

(B) As per the second argument, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

### **Conclusion**



13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art teaches a method for extracting pre-defined data items from medical service records generated by health care providers (5,664,109) and a system and method for physician note creation and management (US 2004/0111296 A1).

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lena Najarian whose telephone number is 571-272-7072. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Ln*

In

3-30-06

*Joseph Thomas*  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER